

REMARKS

This Application has been carefully reviewed in light of the Final Office Action dated January 21, 2009 ("*Office Action*"). Claims 1, 3-12, 14-23 and 25-33 are pending. The *Office Action* rejects Claims 1, 3-11, 23 and 25-33. Applicants currently amends Claim 23. These amendments are fully supported by the specification as originally filed. Applicants respectfully request reconsideration and favorable action in this case.

I. Allowable Subject Matter

Applicants appreciate the Examiner's allowance of Claims 12 and 14-22 as noted in the *Office Action*. Pursuant to 37 C.F.R. § 1.104, Applicants respectfully issue a statement commenting on the Examiner's reasons for allowance. Applicants respectfully disagree with the Examiner's reasons for allowance to the extent that they are inconsistent with applicable case law, statutes, and regulations. Furthermore, Applicants do not admit any characterization or limitation of the claims, particularly any that are inconsistent with the language of the claims considered in their entirety, including all of their constituent limitations, or any characterization of a reference by the Examiner.

II. Response to Examiner's Interview Summary

In response to the Examiner's Interview Summary dated March 11, 2009, Applicants respectfully submit this Response to Interview Summary pursuant to M.P.E.P. § 713.04.

Applicants thank the Examiner for conducting the telephone interview on March 3, 2009 and for thoughtfully considering this case. During the telephone interview, Applicants and Examiner discussed the rejection of Claim 1 under 35 U.S.C. § 101 and the rejection of Claim 23 under 35 U.S.C. § 112, second paragraph, as incomplete for omitting essential structural cooperative relationships. In particular, Applicants and Examiner discussed amending Claim 1 to recite a method for a network node to perform. Applicants and Examiner also discussed citing portions of the specification that support structural cooperative relationships between the controller and the network interface in Claim 23. Examiner indicated that sufficient structural cooperative relationships existed with respect to the memory. It is Applicants' understanding that no agreement was reached regarding this matter.

III. Rejections Under 35 U.S.C. § 101

The *Office Action* rejects Claims 1 and 3-11 under 35 U.S.C. § 101 as directed to non-statutory subject matter. *Office Action*, p. 2. Under the rule recently enunciated in *In re*

Bilski, an invention is patent-eligible if it (1) is tied to a particular machine or apparatus; or (2) transforms a particular article into a different state or thing. *In re Bilski*, No. 2007-1130, slip op. (Fed. Cir. October 30, 2008).

With respect to Claims 1 and 3-11, the *Office Action* argues that “[t]he claimed method for provisioning protection paths is neither tied to a particular machine or apparatus nor transforming a particular article to a different state or thing.” *Office Action*, p. 2. Applicants currently amend Claim 1 to emphasize that a network node performs the recited method steps. Applicants respectfully submit that Applicants’ method, as amended, is patent-eligible.

As further support for the patent-eligibility of Applicants’ method, Claim 1 recites “a protection path from the source node to the destination node spanning a second set of one or more intermediate nodes,” and Claim 1 requires that this protection path be set up. Applicants respectfully submit that “setting up the protection path by notifying the second intermediate nodes to set up the protection path” transforms the “one or more intermediate nodes” of the protection path from a first state to a second state. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of Claims 1 and 3-11 under § 101 and allow these claims.

III. Rejections Under 35 U.S.C. § 112

The *Office Action* rejects Claims 23 and 25-33 under 35 U.S.C. § 112, second paragraph, as incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. *Office Action*, p. 3. Specifically, the *Office Action* states that “[t]he omitted structural cooperative relationships are between the claimed network interface, memory, and controller in independent Claim 23.” *Office Action*, p. 4. Although Applicants believe that all previously pending claims recite definite subject matter under § 112, to advance prosecution, Applicants currently amend Claim 23 to recite: “A network node comprising: a network interface . . . a memory . . . and a controller in communication with the network interface and the memory”

Applicants also cite the following portions of the specification that support a structural cooperative relationship between the claimed network interface and the controller.

The controller supports linking to other network equipment and transporting data communications. *See, e.g., Specification at p. 5, ll. 12-14*: “Each node 12 represents

hardware, including any appropriate controlling logic, capable of linking to other network equipment and transporting data communications.”

The network interface also supports these functionalities. See, e.g., Specification at p. 11, ll. 11-17:

Therefore, the modules and functionalities described may be separate or combined as appropriate, and some or all of the functionalities of node 12 may be performed by logic encoded in media, such as software and/or programmed logic devices. Moreover, while illustrated in primarily functional elements, network 10 contemplates node 12 incorporating any suitable number and type of elements, such as processors, memory devices, network interfaces, and other elements suitable for providing the functionalities described in addition to any other suitable operations.

Specifically, the network interface enables node 12 to interconnect with other network equipment. See, e.g., Specification at p. 8, ll. 32 to p. 9, ll. 1: “network interface 38 may encompass any suitable collection and arrangement of elements that enable node 12 to interconnect with other network equipment, such as other nodes 12 within network 10.”

Therefore, the controller uses controlling logic to link the network node to other network equipment, and the network interface interconnects the network node to the other network equipment in order to enable this linking functionality to be implemented.

As a specific example, for the controller to “initiate setup of the protection path,” as Claim 1 recites, “source node 12 may communicate management messages using an optical supervisory channel to notify other nodes 12 to set up the working path.” Specification, p. 12, ll. 9-11. And for source node 12, using the controller, to communicate management messages to other nodes 12, network interface is necessary to enable the node to interconnect the node to other nodes for the controller to communicate the messages to the other nodes.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of Claims 23 and 25-33 under § 112, second paragraph, and allow these claims.

The *Office Action* also rejects Claims 23 and 25-33 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the *Office Action* states that “[t]here is a lack of antecedent basis for claim language ‘the network configuration information’ in Claim 23, line 3.” *Office Action*, p. 3. Applicants currently amend Claim 23 to correct the typographical error in Applicants’ amendment submitted October 28, 2008.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of Claims 23 and 25-33 under § 112, second paragraph, and allow these claims.

CONCLUSION

Applicants have made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of this Application.

If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Although no fees are believed to be currently due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants

A handwritten signature in black ink, appearing to read 'Kurt M. Pankratz', with a long horizontal flourish extending to the right.

Kurt M. Pankratz
Reg. No. 46,977
(214) 953-6584

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Customer Number: **05073**